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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,144	06/23/2000	Gregory Jones	5053-28000	1593

7590

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EXAMINER

FRENEL, VANEL

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 04/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/603,144

Applicant(s)

JONES ET AL.

Examiner

Vanel Frenel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8 and 9. 6) ☐ Other:

## **DETAILED ACTION**

### **Notice to Applicant**

1. This communication is in response to the amendment filed January 17, 2003.

Claims 1-40 are pending.

### ***Information Disclosure Statement***

2. The information disclosure statement filed on 3/4/03 and 3/11/03 respectively fails to comply with 37 CFR 1.97(c) because it lacks the fee set forth in 37 CFR 1.17(p). It has been placed in the application file, but the information referred to therein has not been considered.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKee et al (6,272,482) in view of Hammond et al (5,613,072).

(A) As per claim 1, McKee discloses a system comprising: a rules engine which is operable to assess a value of an insurance claim as a function of a plurality of rules

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(Col.1, lines 6-37); a database which stores rules data which is transformable to said plurality of rules (Col.1, lines 6-57).

McKee does not explicitly disclose said database is separate from said rules engine. However, this feature known in the art, as evidenced by Hammond. In particular, Hammond suggests a database which is separated from said rules engine (Col.13, lines 54-67 to Col.14, line 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Hammond within the system of McKee for providing a generated models which are installed onto a designated computer accessible by the insurance carrier. The insurance carrier maintains and updates its active workers' compensation claims on a host computer at the carrier facility (See Hammond Col.2, lines 31-34).

(B) As per claim 2, McKee discloses the system further comprising: a translator program which is operable to read said rules data from said database and transform said rules data into said plurality of rules for use by said rules engine (Col.7, lines 5-26).

(C) As per claim 3, McKee discloses the system wherein said translator program is operable to read said rules data from said database (Col.6, lines 10-34).

(D) As per claim 4, McKee discloses the system wherein said translator program is programmed in an object-oriented programming language (Col.5, lines 32-52); wherein said translator program comprises a plurality of objects (Col.5, lines 32-52).

(E) As per claim 5, McKee discloses the system wherein said translator program is configured to be modified as a function of business requirements of an insurance organization to form a modified translator program (Col.3, lines 44-67).

(F) As per claim 6, McKee discloses the system wherein said rules data are configured to be modified as a function of business requirements of an insurance organization to form modified rules data (Col.3, lines 44-67); wherein said translator program is configured to be modified as a function of business requirements of an insurance organization to form a modified translator program (Col.5, lines 1-52); and wherein said customized translator program is configured to read said modified rules data from said database and transform said modified rules data into a modified plurality of rules (Col.6, lines 10-34).

(G) As per claim 7, McKee discloses the system wherein said plurality of rules are operable in real-time by said rules to engine to assess said value of said insurance claim (Col.7, lines 16-26).

(H) As per claim 8, McKee discloses the system wherein said rules data are configured to be modified as a function of business requirements of an insurance organization to form modified rules data (Col.1, lines 6-57).

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(I) As per claim 9, Hammond discloses the system wherein said insurance claim comprises a bodily injury claim, and wherein said value of said insurance claim comprises a trauma severity value (Col.4, lines 33-66).

(J) As per claim 10, McKee discloses the system wherein said rules data is stored in a tabular format in said database (Col.6, lines 10-34).

(K) As per claim 11, McKee discloses the system further comprising: a CPU (Col.6, lines 10-19); a memory coupled to the CPU, wherein said rules engine comprises program instructions which are stored in said memory and executable by said CPU (Col.6, lines 10-24).

(L) As per claim 12, McKee discloses the system wherein said rules comprise logical instructions for assessing said value of said insurance claim (Col.6, lines 10-34).

(M) As per claim 13, McKee discloses the system wherein each rule comprises a premise and one or more resulting actions for assessing said value of said insurance claim (Col.5, lines 1-52).

(N) As per claim 14, McKee discloses the system further comprising: a reporter program which is operable to read said rules data in said database and generate reports using said rules data (Col.6, lines 10-34; Col.7, lines 15-65).

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(O) As per claim 15, McKee discloses the system wherein said rules data comprises alphanumeric values stored in said database (Col.5, lines 53-60).

(P) As per claim 16, McKee discloses the system wherein said plurality of rules are configured to be updated by updating said rules data stored in said database (Col.7, lines 5-36).

(Q) As per claim 17, McKee disclose a method comprising: providing a rules engine which is operable to assess a value of an insurance claim as a function of a plurality of rules (Col.3, lines 44-67; Col.4, lines 25-51); providing a database which stores rules data which is transformable to said plurality of rules (Col.1, lines 6-57), reading said rules data from said database (Col.6, lines 10-34); and transforming said rules data into said plurality of rules for use by said rules engine(Col.1, lines 6-57).

McKee does not explicitly disclose database is separate from said rules engine. However, this feature is known in the art, as evidenced by Hammond. In particular, Hammond suggests a database which is separated from said rules engine (Col.13, lines 54-67 to Col.14, line 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Hammond within the system of McKee for providing a generated models which are installed onto a designated computer accessible by the insurance carrier. The insurance carrier maintains and updates its active workers' compensation claims on a host computer at the carrier facility (See Hammond Col.2, lines 31-34).

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(R) As per claim 18, Hammond discloses the method further comprising: assessing said value of said insurance claim as a function of said plurality of rules by determining a trauma severity value, wherein said insurance claim comprises a bodily injury claim (Col.4, lines 33-67).

(S) As per claim 19, McKee discloses the method wherein said rules data is stored in a tabular format in said database (Col.6, lines 10-34).

(T) As per claim 20, McKee discloses the method wherein said rules engine comprises program instructions which are to executable by a computer (Col.6, lines 10-19).

(U) As per claim 21, McKee discloses the method wherein said rules comprise logical instructions for assessing said value of said insurance claim (Col.5, lines 1-42).

(V) As per claim 22, McKee discloses the method wherein each rule comprises a premise and one or more resulting actions for assessing said value of said insurance claim (Col.5, lines 1-52).

(W) As per claim 23, McKee discloses the method wherein said rules data comprises alphanumeric values stored in said database (Col.5, lines 53-60).



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(X) As per claim 24, McKee discloses the method further comprising: updating said plurality of rules by updating said rules data stored in said database (Col.7, lines 5-36).

(Y) As per claim 25, McKee discloses the method further comprising: updating said rules data in said database (Col.7, lines 5-36); reading said updated rules data from said database (Col.6, lines 10-34); and transforming said updated rules data into updated plurality of rules for use by said rules engine (Col.1, lines 6- 57).

(Z) As per claim 26, McKee discloses the method further comprising: modifying said rules data as a function of business requirements of an insurance organization to form modified rules data (Col.6, lines 10-34).

(AA) As per claim 27, McKee discloses the method further comprising: modifying said plurality of rules to form a modified plurality of rules by using said modified rules data (Col.6, lines 10-34).

(BB) As per claim 28, McKee discloses the method wherein said rules data comprises a plurality of units of line text and a plurality of templates, wherein each of said templates comprises one or more slots, and wherein said transforming said rules data into said plurality of rules comprises, for each of said plurality of rules, replacing said one or more of said slots in one of said templates with one or more of said units of line text (Col.2, lines 8-20; Co.1.6, lines 6-47; Col.7, lines 36-50).

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(CC) As per claim 29, McKee discloses a carrier medium comprising program instructions, wherein said program instructions are computer-executable to implement: providing a rules engine which is operable to assess a value of an insurance claim as a function of a plurality of rules (Col.3, lines 44-67); providing a database which stores rules data which is transformable to said plurality of rules (Col.1, lines 6-57); reading said rules data from said database (Col.6, lines 10-34); and transforming said rules data into said plurality of rules for use by said rules engine (Col.1, lines 6-57).

McKee does not explicitly disclose wherein said database is separate from said rules engine. However, this feature is known in the art, as evidenced by Hammond . In particular, Hammond suggests wherein said database is separate from said rules engine (Col.13, lines 54-67 to Col.14, line 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Hammond within the system of McKee for providing a generated models which are installed onto a designated computer accessible by the insurance carrier. The insurance carrier maintains and updates its active workers' compensation claims on a host computer at the carrier facility (See Hammond Col.2, lines 31-34).

(DD) Claims 30-40 recite the underlying process steps of the elements of claims 18-28. As the various elements of claims 18-29 have been shown to be either disclosed by or obvious in view of the collective teachings of McKee and Hammond, it is readily apparent that the carrier-medium disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 30-40 are

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rejected for the same reasons given above for method claims 18-28, and incorporated herein.

### Response to Arguments

5. Applicant's arguments filed 1/17/03 regarding claims 1-40 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in response filed 1/17/03.

(A) At page 2 of the 1/17/03 response, Applicant argues to establish a prima facie obviousness of a claimed invention, all limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180, USPQ 580 (CCPA 1974), MPEP 2143.03.

However, Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2D 1443, 1445, 24 USPQ2D 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468,1472, 223 USPQ 785, 788 (Fed. Cir.1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (See paper # 6).

Rather, Applicant does not point any specific distinction (s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111 (b) states, " A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the applied references. Simply stated, what distinctions, if any, are there between Applicant's recited database which stores rules, transformation program which is executable to read rules data and logical instructions for assessing the value of an insurance claim and the corresponding elements of the Mc Kee and Hammond references? Also, arguments or conclusions of Attorney cannot take the place of evidence. In re Cole, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); In re Schulze, 52 CCPA 1422, 346 F. 2d 600, 145 USPQ 716 (1965); Mertizner v. Mindick, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

In response to Applicant's arguments against the references individually, one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 208

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USPQ 871 (CCPA 1981). Therefore, the combination of references is proper and the rejection maintained.

(B) On page 2-3, Applicant 's argues that McKee does not teach or suggest a rules engine operable to determine the value of an insurance claim. However, the Examiner disagrees.

In response to Applicant's arguments, Examiner respectfully suggests "rules mapping to the state laws for e.g., auto liability limits, allowable auto deductibles, auto cancellation and renewal notification requirements property mandatory coverages, property deductible and liability limits, etc. Each jurisdiction contains the set of governing business rules representing each and every regulation involving auto insurance, property insurance, and life insurance" which can be considered as a rules of engine since the rules engine for insurance is intended to perform the same role (See McKee, Col.2, lines 25-38).

In addition, on page 3, Applicant argues that McKee does not teach or suggest determining the value of an insurance claim based on a plurality of rules. However, the Examiner disagrees.

In response to Applicant's arguments, Examiner suggests that "control point is one of the possibly several control points used in making the business decision 8 of when to cancel an insured's policy (other control points are indicated at 7b and 7c, but mapping of rules to those control points are omitted to simplify the drawing). Rules from jurisdictions 6h and 6i pertaining to life and property insurance are thus dropped from consideration, as are all of the rules from the Houston"(See McKee, Col.5, lines 3-31).

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(C) On page 4, Applicant's argues that McKee does not teach or suggest a database which stores rules data transformable to from the rules. However, the Examiner disagrees.

In response to Applicant's arguments, Examiner respectfully suggests "a network adapter 90, and floppy disk drive 40, each of which may be internal or external to the enclosure or processor 22". Furthermore, McKee suggests combination of the memory devices may be used to store program instructions which carry out business rules management system (See McKee, Col.5, lines 53-67 to Col.6, line 56).

In addition, Applicant's argues that McKee does not appear to teach or suggest "wherein said database is separate from said rules of engine. However, Examiner disagrees.

In response to Applicant's arguments, Examiner respectfully suggests "claim prediction using models which is accomplished via direct communication between a host computer at the insurance an the insurance carrier's facility, for example, a carrier's multipurpose mainframe computer can also be read as a database which is separated from the rule of engine (See Hammond, Col.13, lines 54-67).

(D) On page 5, Applicant's argues that McKee does not teach or suggests "a translator program which is operable to read said rules data from said database and transform said rules data into said plurality of rules for use by said rule engine. However, Examiner disagrees.

In response to Applicant's arguments, Examiner respectfully suggests " the data processing system 20 is controlled primarily by computer readable instructions, which

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can be in the form of software, wherever, or by whatever means such software is stored or accessed. Such software may be executed within the Central Processing Unit (CPU) 50 to cause data processing system 20 to do the work (See McKee, Col.6, lines 10-20).

Any combination of these memory devices may be used to store program instructions which carry out the business rules management system of the present invention (See McKee, Col.6, lines 10-56).

(E) On page 6, Applicant's argues that McKee does not teach or suggest a transformation program which is executable to read data from a database and transform the rules data into a plurality of rules. However, the Examiner disagrees.

In response to Applicant's arguments, Examiner respectfully suggests businesses use a wide variety of computer hardware and software products, for many different purposes. Furthermore, McKee suggests "Object-oriented systems are developed using object -oriented programming languages in which each variable, function, etc., can be considered an object of a particular "class", having particular attributes. C++ and Java are examples of object-oriented programming languages, and provide advanced programming features such as polymorphism, encapsulation, and inheritance. An object-oriented application that makes decisions or solves problems by using analytical rules, is often referred to as an expert system" (See McKee, Col.1, lines 6-67 to Col.2, line 32).

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

#### Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches case management for a personal injury plaintiff's law office using a relational database (6,098,070); method and apparatus for deterring frivolous professional liability claims (6,272,471) and insurance claims estimate, text, and graphics network and method (5,504,674).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on 6:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9643.

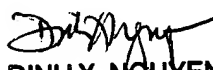


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The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

V.F  
V.F

  
DINH X. NGUYEN  
PRIMARY EXAMINER

April 5, 2003